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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,852	05/31/2001	Claus Frohberg	514413-3864	5091

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NEW YORK, NY 10151

EXAMINER

KALLIS, RUSSELL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/744,852

Applicant(s)

FROHBERG, CLAUS

Examiner

Russell Kallis

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12/8/2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-5,7-21,26-27,29-42.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 05 June 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 3. Applicant's reply has overcome the following rejection(s): 35 U.S.C. 102(b), 103(a), and 112 2nd /101 utility.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments for a claim to a genus of amino acid sequences having 85% sequence identity to SEQ ID NO: 2 and having the claimed function does not overcome the 112 1st rejection under written description because Applicant has disclosed only one species with no identification of essential residues or conserved sequences that define the genus so that one of skill in the art would be able to identify a polypeptide having 85% sequence identity to SEQ ID NO: 2 having the claimed activity. Further, Applicant's arguments that making a fragment of SEQ ID NO: 1 is not undue experimentation is a repetition of previous arguments and does not address the enablement rejection of Applicant's claim to a broad genus of fragments that inhibit synthesis of endogenous beta-amylase when introduced into plants, namely that in order to practice the invention one of skill in the art would be required to practice undue trial and error experimentation to find an operable embodiment of the invention from a multitude of non-exemplified fragments. Furthermore, since Applicant has not described any polynucleotide, other than SEQ ID NO: 1 that encode a polypeptide sequence having at least 85% sequence identity to SEQ ID NO: 2 and having the function of a potato beta-amylase, Applicant has not taught any method of using said polynucleotide.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

